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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,848	02/28/2002	Masao Mikumo	763-30	7368

7590 06/16/2006

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EXAMINER

ALEXANDER, LYLE

ART UNIT PAPER NUMBER

1743

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/069,848

Applicant(s)

MIKUMO ET AL.

Examiner

Lyle A. Alexander

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-21 and 24-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20,21,34 and 37-39 is/are allowed.
- 6) ☒ Claim(s) 17-19, 24-33 and 35-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

In response to the 3/8/06 "Decision" the finality of the 11/30/05 Office action has been removed. This Office action is in response to the 5/5/06 remarks.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 17-19, 24-33 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-30986 or JP 5-320616 in view of JP '904.

See the appropriate paragraph of the 11/8/04 Office action.

The preliminary amendments have added the limitations to claim 17 that the indicator changes from colorless to colored. New claim 40 specifies the color tone change occurring by opening of the lactone ring.

'986 teach in the abstract " An electron donative type coloring organic compound ..." which suggest the compound is coloring. Furthermore, because the instant claims are directed to the identical indicators, e.g. flourans, it would have been inherent both have the same colorimetric characteristics.

The abstract of '986 also teaches "... developers can open the rings such as lactone rings ..." which is indistinguishable from claim 40.

***Response to Arguments***

Applicant's arguments filed 5/5/06 have been fully considered but they are not persuasive.

The 5/5/06 claims state that no amendments have been made to the claims and the claims are listed as a courtesy the Examiner. However, the 5/5/06 claims are not a

copy of the pending 5/11/05 claims. For the purposes of examination, the Office will review the 5/11/05 claims. Clarification and correction are required.

Applicants' state JP '986 teach additional compounds that are not taught by the instant claims. These remarks are not commensurate in scope with the instant claims that have open language and do not exclude addition compounds.

Applicants' state that unexpected results are achieved with the instant invention. Applicants' are encouraged to make the claims commensurate in scope with their remarks. Additionally, a timely and properly filed 1.132 Declaration may be helpful in a showing of unexpected results.

Applicants' state JP'616 does not teach the claimed "dithiocarbamyl coloring assistant". The Office agrees, noting this reference has been rejection under 35 USC 103 in view of JP '904 that does teach the claimed "dithiocarbamyl coloring assistant".

Applicants' state JP'904 does not teach the claimed fluoran containing pigment. The Office agrees and notes JP'904 has been applied under 35 USC 103 as teaching the claimed "dithiocarbamyl coloring assistant" and not the fluoran containing pigment.

Applicants' state there is no motivation to make the above combination of JP 10-30986 or JP 5-320616 in view of JP '904. The Office does not agree and maintains there is sufficient motivation on record.

***Allowable Subject Matter***

Claims 20-21,34 and 37-39 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The cited prior art fails to teach or anticipate the use of a polyphenyl compound

as a discoloring agent in an indicator composition for plasma sterilization comprising a colorless chromogenic fluoran pigment and a coloring assistant.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lyle A Alexander  
Primary Examiner  
Art Unit 1743



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